

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

FILED
U. S. DISTRICT COURT
Eastern District of Texas
AUG 26 2004

DAVID MALAND, CLERK
By
Deputy _____

ORION IP, LLC,
a Delaware Limited Liability Corporation
Plaintiff,

v.

1. STAPLES, INC.,
a Delaware Corporation;
2. PEP BOYS – MANNY, MOE &
JACK, INC., a Pennsylvania corporation,
3. FUJI PHOTO FILM, USA, INC.,
a New York corporation,
4. HITACHI AMERICA, LTD.,
a New York corporation,
5. HOME DEPOT USA, INC.
a Delaware corporation,
6. HARLEY-DAVIDSON, INC.
a Wisconsin corporation,
7. TOYOTA MOTOR SALES, USA, INC.,
a California corporation,
8. ALFORD BUICK PONTIAC GMC,
INC. dba ALFORD TOYOTA,
a Delaware corporation,

Defendants.

Civil Action No. 2:04-CV-297 TJW

(WARD)

JURY DEMANDED

FIRST AMENDED ORIGINAL COMPLAINT FOR PATENT INFRINGEMENT

This is an action for patent infringement in which Orion IP, LLC makes the following allegations against Staples, Inc., Pep Boys—Manny Moe & Jack, Inc., Fuji Photo Film, USA,

Inc., Hitachi America, Ltd., Home Depot USA, Inc., Harley-Davidson, Inc., Toyota Motor Sales, USA, Inc. and Alford Buick Pontiac GMC, Inc. dba Alford Toyota.

PARTIES

1. Plaintiff Orion IP, LLC (“Orion”) is a Delaware limited liability company with its principal place of business at 74-785 Highway 111, Suite 103, Indian Wells, California 92210.

2. Defendant Staples, Inc. (“Staples”) is a Delaware corporation with its principal place of business in Framingham, Massachusetts, and has offices and stores throughout the United States, Texas, and the Eastern District of Texas.

3. Defendant Pep Boys – Manny Moe & Jack (“Pep Boys”) is a Pennsylvania corporation with its principal place of business at Philadelphia, Pennsylvania, and has offices and stores throughout the United States, Texas and the Eastern District of Texas.

4. Defendant Fuji Film USA (“Fuji Film”) is a New York corporation with its corporate headquarters and its principal place of business at Valhalla, New York. Fuji Film also has offices in Carrollton, Texas.

5. Defendant, Hitachi America, Ltd., (“Hitachi”) is a New York corporation with its corporate headquarters and principal place of business at Brisbane, California. Hitachi also has division and group companies with offices throughout the United States, including Dallas, Texas.

6. Harley-Davidson, Inc. (“Harley-Davidson”) is a Wisconsin corporation with its corporate headquarters and principal place of business in Milwaukee, Wisconsin and also has dealers and distributors throughout the State of Texas and the Eastern District of Texas, including Longview, Texas.

7. Home Depot USA, Inc. ("Home Depot") is a Delaware corporation with its corporate headquarters and principal place of business at Atlanta, Georgia, and also has offices throughout Texas and the Eastern District of Texas.

8. Toyota Motor Sales, USA, Inc. ("Toyota USA") is a California corporation with its corporate headquarters and principal place of business in Torrance, California, and offices in California, Colorado, Illinois, Maryland, Massachusetts, Missouri, New Jersey, Ohio, Oregon, Florida and Texas, and a distribution center in Dallas, Texas. Toyota USA also has logistic and parts distribution operations throughout the United States, including Texas. Toyota USA has a manufacturing plant in San Antonio, Texas. Toyota USA has dealers throughout the State of Texas and the Eastern District of Texas, including Marshall, Texas.

9. Alford Buick Pontiac GMC, Inc. dba Alford Toyota ("Alford Toyota") is a Delaware corporation with its headquarters and principal place of business in Marshall Texas.

JURISDICTION AND VENUE

10. This action arises under the patent laws of the United States, Title 35 of the United States Code. This Court has subject matter jurisdiction pursuant to 28 U.S.C. §§ 1331 and 1338(a).

11. Venue is proper in this district under 28 U.S.C. §§ 1391(c) and 1400(b). Defendants each have a regular and established place of business in this district, has transacted business in this district and, on information and belief, has committed acts of patent infringement in this district.

COUNT 1

INFRINGEMENT OF U.S. PATENT NO. 5,615,342

12. Orion, is the owner by assignment of United States Patent No. 5,615,342 ("the '342 patent") entitled "Electronic Proposal Preparation System," a true copy of which is attached as Exhibit A, duly issued on March 25, 1997

13. The '342 Patent was invented by Jerome D. Johnson.

14. Defendants Pep Boys, Fuji Photo Film, Hitachi, Home Depot, Harley-Davidson, Toyota USA and Alford Toyota have been and now are directly infringing, and indirectly infringing by way of inducing infringement and/or contributing to the infringement of the '342 patent in the state of Texas, in this judicial district, and elsewhere in the United States by, among other things, making and using supply chain methods, sales methods, sales systems, marketing methods, marketing systems and inventory systems covered by one or more claims of the '342 patent to the injury of Orion.

15. These defendants have actively induced and are actively inducing infringement of the '342 patent.

16. As a result of these Defendants' infringement of the '342 patent, Orion has suffered monetary damages in an amount not yet determined, and will continue to suffer damages in the future unless Defendants' infringing activities are enjoined by this Court.

17. Unless a preliminary and permanent injunction are issued enjoining these Defendants and their agents, servants, employees, attorneys, representatives, affiliates and all other acting on their behalf from infringing the '342 patent, Orion will be greatly and irreparably harmed.

COUNT 2

INFRINGEMENT OF U.S. PATENT NO. 5,367,627

18. Orion, is the owner by assignment of United States Patent No. 5,367,627 (“the ‘627 patent”) entitled “Computer-Assisted Parts Sales Method,” a true copy of which is attached as Exhibit B, duly issued on November 22, 1994.

19. The ‘627 Patent was invented by Jerome D. Johnson.

20. Defendants Staples, Pep Boys, Fuji Photo Film, Hitachi, Home Depot, Harley-Davidson, Toyota USA and Alford Toyota have been and now are directly infringing, and indirectly infringing by way of inducing infringement and/or contributing to the infringement of the ‘627 patent in the state of Texas, in this judicial district, and elsewhere in the United States by, among other things, making and using supply chain methods, sales methods, sales systems, marketing methods, marketing systems and inventory systems covered by one or more claims of the ‘627 patent to the injury of Orion.

21. Defendants have actively induced and are actively inducing infringement of the ‘627 patent.

22. As a result of Defendants’ infringement of the ‘627 patent, Orion has suffered monetary damages in an amount not yet determined, and will continue to suffer damages in the future unless Defendants’ infringing activities are enjoined by this Court.

23. Unless a preliminary and permanent injunction are issued enjoining Defendants and their agents, servants, employees, attorneys, representatives, affiliates and all others acting on their behalf from infringing the ‘627 patent, Orion will be greatly and irreparably harmed.

PRAYER FOR RELIEF

WHEREFORE, Orion requests that this Court:

1. A judgment in favor of Orion that Defendants Pep Boys, Fuji Photo Film, Hitachi, Home Depot, Harley-Davidson, Toyota USA and Alford Toyota have infringed, directly and indirectly by way of inducing and/or contributing to the infringement of the '342 patent.

2. A permanent injunction, enjoining Defendants Pep Boys, Fuji Photo Film, Hitachi, Toyota, Home Depot, Harley-Davidson, Toyota USA and Alford Toyota and their officers, directors, agents, servants affiliates, employees, divisions, branches subsidiaries, parents and all others acting in concert or privity with any of them from infringement, inducing the infringement of, or contributing to the infringement of the '342 patent.

3. A judgment and order requiring Defendants Pep Boys, Fuji Photo Film, Hitachi, Home Depot, Harley-Davidson, Toyota USA and Alford Toyota to pay Orion damages for Defendants' infringement of the '342 patent, together with interest (both pre- and post-judgment), costs and disbursements as fixed by this Court under 35 U.S.C. §284;

4. A judgment in favor of Orion that Defendants Staples, Pep Boys, Fuji Photo Film, Hitachi, Home Depot, Harley-Davidson, Toyota USA and Alford Toyota have infringed, directly and indirectly by way of inducing and/or contributing to the infringement of the '627 patent.

5. A permanent injunction, enjoining Defendants Staples, Pep Boys, Fuji Photo Film, Hitachi, Home Depot, Harley-Davidson, Toyota USA and Alford Toyota and their officers, directors, agents, servants affiliates, employees, divisions, branches subsidiaries, parents and all others acting in concert or privity with any of them from infringement, inducing the infringement of, or contributing to the infringement of the '627 patent.

6. A judgment and order requiring Defendants Staples, Pep Boys, Fuji Photo Film, Hitachi, Home Depot, Harley-Davidson, Toyota USA and Alford Toyota to pay Orion damages

for Defendants' infringement of the '627 patent, together with interest (both pre- and post-judgment), costs and disbursements as fixed by this Court under 35 U.S.C. §284;

7. A judgment and order finding that this is an exceptional case within the meaning of 35 U.S.C. §285 and awarding to Orion its reasonable attorneys' fees; and

ORION DEMANDS A TRIAL BY JURY ON ALL ISSUES SO TRIABLE.

Dated: August 26, 2004

Respectfully submitted,

ORION IP, LLC

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